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## Comments

RE: Patent Application No.: 09/679,391  
Filing Date: October 3, 2000  
Inventor: Bates, et al.  
Title: Method and Apparatus for Associating the Color of an Object with an Event  
Confirmation No.: 6681

Please file the attached:  
Transmittal Form (1p.)  
Reply to Examiner's Answer of November 16, 2005 (7 pp.)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/679,391
	Filing Date	October 3, 2000
	First Named Inventor	Bates, et al.
	Art Unit	2676
	Examiner Name	Blackman, Anthony J.
Total Number of Pages in This Submission	Attorney Docket Number	213187-00002

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s): Bates, et al.

Application No.: 09/679,391

Filed: October 3, 2000

For: Method and Apparatus for Associating the  
Color of an Object with an Event

Group Art Unit: 2676

Examiner: Blackman, Anthony J.

Customer No.: 27160

Confirmation No.: 6681

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**REPLY TO EXAMINER'S ANSWER OF NOVEMBER 16, 2005**

Sir:

Pursuant to 37 C.F.R. §41.41, the Applicant hereby submits a reply to the Examiner's Answer within two months thereof. The Reply Brief does not include any new or non-admitted affidavit or other evidence. Accordingly, it is respectfully requested that the Reply Brief be entered.

Claims 31-36 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Rangan, et al., U.S. Patent No. 6,198,833. Claims 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rangan, et al., in view of Issadore-Barreca, et al., U.S. Patent

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No. 6,205,231 ("the Issadore-Barreca, et al. patent"). Each of these rejections are addressed below.

### **CLAIM REJECTIONS - 35 U.S.C. § 102**

Claims 31-36 have been rejected under 35 U.S.C. § 102(e) as being anticipated by the Rangan, et al. patent. It is hornbook law that in order for there to be anticipation, each and every one of the elements of the claim must be contained in a single reference. If a single element is missing from the claim, there can be no anticipation. As will be discussed in more detail below, even though the method and system in both the Rangan, et al. patent and the claims at issue are directed to image processing and more particularly, identifying selected objects in a video frame to be automatically located in other video frames in a sequence of video frames, the technique used by the two systems differs drastically. In particular, there are many significant differences between the system disclosed in the Rangan, et al. patent and the system recited in the claims at issue. First, the system recited in the claims at issue relates to determining a location in a video frames where an action by a pointing device has occurred defining a selected location. It is respectfully submitted that the Examiner has improperly used extrinsic evidence to define terms in the claim, contrary to the Court of Appeal and the Federal Circuit in *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed.Cir. 2004). Indeed, as set forth on page 13 of the Examiner's answer, the Examiner has relied on a definition from the Microsoft Press Computer Dictionary, 3rd Ed., page 20 to define the pointing device as recited in the claims at issue. As the Court of Appeal Federal Circuit has clearly pointed out, extrinsic evidence such as dictionary, are generally not permissible for defining terms in a claim. Rather, the Court held that the patent specification as well as the file history are used to define the terms in a claim. As clearly set forth on page 14 of the specification, the pointing device recited in the claims clearly relates to a mouse and a mouse button ("According to the embodiments of the present invention, the user provides input on some area of a display device, for instance, by depressing a mouse button at a specified location. The invention then determines where the user has to press the mouse button and what color value

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appears on the display device at the time the user has depressed the mouse button." page 14, lines 9-12).

The tracking system disclosed in the Rangan, et al. patent is different. In this case, a tracking element 29 is selected and dragged over the object to be tracked, as illustrated in Fig. 3, below.

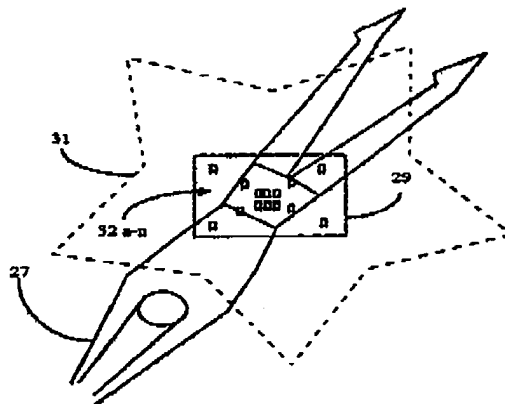


Fig. 3

as set forth in column 7, lines 7-13, et seq. of the Rangan, et al. patent: "To begin, an editor selects, typically by well-known cursor technique, a tracking element 29, a preselected shape and size, and place it (drag and drop), click on, etc. the selected element over an image entity to be tracked with the center point of the element substantially centered on the image entity to be tracked or at least on a portion of the entity." Thus, it should be clear that the Rangan, et al. patent clearly does not determine a location in a video frame or an action by a pointing device (i.e., mouse) has occurred, defining a selected location.

Claims 31 and 32 recite determining a color value for the selected location. Claims 33 and 34 recite determining a color range for the selected object.

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The Rangan, et al. patent teaches utilizing a tracking element 29 and determines the signature of the pixels within the tracking element 29. The color signature relates to the location and value of the pixels, for example, the pixels 32 a-n in Fig. 3 above. The system then uses assumptions regarding the movement of the object to determine subsequent location of the object. However, the color signature for the assumed locations and subsequent frames is verified ("Typically, in a single frame, an entity, unless moving uncommonly rapidly, will not have moved far. A pattern of assumed center points in an expanding spiral around the original center point of the tracking element is therefore assumed and the test pixel pattern at each assumed center point is taken and compared to the stored base signature. Thus, match to the stored signature is taken to be the new position of the image entity to be tracked ..." Rangan, et al. patent, column 9, lines 30-37).

As such, it is respectfully submitted that the Rangan, et al. patent clearly does not automatically associate an event with a color value associated with a selected location, as recited in claims 31 and 32 or a color range of a selected location as recited in claims 33 and 34. For all of the above reasons, it is clear that claims 31-36 recite elements clearly not disclosed or suggested by the Rangan, et al. patent.

#### **CLAIM REJECTIONS – 35 U.S.C. § 103**

Claims 37 and 38 have been rejected under U.S.C. § 103(a) as being unpatentable over the Rangan, et al. patent, in view of the Issadore-Barreca, et al. patent. As stated in the Applicant's Appeal Brief, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness as required by MPEP § 2143. In particular, in order to establish a *prima facie* case of obviousness, three criteria must be met. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must a reasonable expectation of success. Finally, the prior art reference (or reference when combined) must teach or suggest all the claim limitations. The

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teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure."

It is respectfully submitted that the Examiner has failed to show a reasonable expectation of success. In particular, the Rangan, et al. patent relates to a method for tracking a selected object and video frame by acquiring the color signature of a region of interest bounded by the tracking element 29 (Fig. 3, Rangan, et al. patent). The Issadore-Barreca, et al. patent, on the other hand, utilizes edge detection for tracking the edge of tags placed around an object of interest. Accordingly, it is respectfully submitted that the Examiner has failed to show that there is a reasonable expectation of success of the claim combination.

Also, it is respectfully submitted that the specific combination being relied upon by the Examiner is not clearly defined. In particular, on page 9 of the Examiner's Answer, the Examiner states: "It would have been obvious to one skilled in the art at the time of the invention to use the '... widely-practiced edge technique known as Sobel's algorithm is used to detect an object 20. The edge is according to Gonzales and Woods, a boundary between two regions of an image ...' Issadore-Barreca, et al. modifies "a method for tracking a moving entity in a video presentation ... of Rangan, et al. because both inventions share similar technological environments corresponding to the processing of moving images ... and tracking moving entities in a video presentation." (Examiner's answer pages 9 and 10).

Moreover, the Examiner has clearly failed to show that there was motivation to combine the teachings of the two patents. It appears that the Examiner is relying on statements on page 20 of the Examiner's answer that the suggestion is "because both inventions share technological environment corresponding to the processing of moving video images." (Examiner's Answer, Page 20). The Examiner also states "In response to Applicant's arguments at the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is, in a sense, necessarily a reconstruction based on hindsight (Examiner's Answer, Pages 20 and 21). Based on the above, it is respectfully submitted that the Examiner has also failed to show that there was motivation to combine the references and has

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even admitted in his answer that the motivation was based on hindsight. For all of the above reasons, it is respectfully submitted the Examiner has failed to set forth a *prima facie* case of obviousness.

#### **OTHER ISSUES**

The Applicant would also like to address several points that appear on pages 13-21 of the Examiner's Answer.

1. The Examiner is relying on Microsoft Press Computer Dictionary to support his rejection. This dictionary is not of record. Moreover, as discussed above, the dictionary is improper for interpreting claims as set forth by the Court of Appeals for the Federal Circuit in *Phillips, supra*, Examiner's Answer page 13.

2. The Examiner states in various locations that the Applicant has argued subject matter that is not recited in the claim.

- Extremely computation – intensive arduous task invention of Rangan, et al. (page 15)
- Examiner's Answer, page 21, first Appellant, once again, argues subject matter that is not recited in the claim language by discussing an interactive t.v.

It is respectfully submitted that the Examiner is improperly requiring all arguments regarding the benefits and limitations of the invention to be included in the claims. It is respectfully submitted that there is no such requirement for including benefits and limitations made in arguments to distinguish references in the claims.

3. The Applicant also respectfully traverses the Examiner's statement that the arguments fail to comply with the 37 CFR 1.111(b) for failing to point out how the invention distinguishes from the references. As shown on page 16, the basis for this assertion appears to be that the Applicant has argued that the Rangan system is arduous and computationally intensive and that the Applicant has failed to replace the word "comprising" with the word "consisting" as suggested by the Examiner. It is respectfully submitted that the Examiner's basis for suggesting that the Applicant has failed to comply with 37 CFR 1.111(b) are inappropriate. This argument is also repeated in the Examiner's Answer, page 18.



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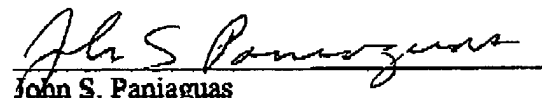
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4. Regarding the Examiner's Answer, page 22, the clear implication of the last paragraph of the Examiner's Answer is if the term "comprising" had been substituted in the claims with the word "consisting" that all of the rejected claims would be allowed. It is respectfully submitted that such a statement clearly undermines the Examiner's position on the rejections set forth above. For all of the above reasons, the Board is respectfully requested to reverse the Examiner's rejection of the claims.

Respectfully submitted,

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Date: Jan 17, 2006

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